

## **REMARKS**

### **I. Status of the Claims**

Claims 1-20 are pending in this Application. Claim 19 has been amended so that it now depends upon claim 18. Accordingly, no new matter has been introduced by this Amendment.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned "Version with markings to show changes made."

### **II. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claim 19 under 35 U.S.C. § 112, second paragraph, as indefinite because it refers to a non-existing claim, claim 21. Applicants have amended claim 19 so that it now depends upon claim 18. Accordingly, Applicants respectfully request withdrawal of this rejection.

### **III. The Rejection Under 35 U.S.C. §102(a)**

The Examiner has rejected claim 1 as allegedly anticipated by Herman. The Examiner relies upon Herman as disclosing the "that the basic components of ringing gel formulations are oil, water, a surfactant, and a cosurfactant." The Examiner also argues that the disclosure of carbomer at page 24 reads on the benefit agent of Applicants claimed invention. Applicants respectfully traverse this rejection.

The claimed invention relates to a method of depositing a benefit agent on a keratinous surface, said method comprising topically applying to said surface an effective amount of a ringing gel composition comprising (a) a surfactant phase ; (b) an oil phase; and (c) a benefit agent. As discussed in the Specification, Applicants have discovered that ringing gel compositions according to the invention may be used to deposit benefit agents onto keratinous substrates, such as the skin, hair and nails of a human or animal, even after rinsing the composition off of the skin. This finding of a "2 in 1" composition, where the product cleanses as well as leaves a particular benefit agent behind is novel, as one would expect that the cleansing surfactants present in the composition would remove all of the benefit agent from the surface.

As the Examiner is well aware, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

See M.P.E.P. § 2131. Here, Herman fails to teach or suggest that the ringing gel compositions broadly disclosed therein could be used to deposit a benefit agent on a keratinous surface. The Examiner argues that the carbomers mentioned by Herman read on the benefit agent recited by the present claims. Applicants respectfully disagree. Herman specifically teaches that carbomers are added as a thickener. Thickeners are not benefit agents as defined in Applicants invention. As discussed in the Specification, the term "benefit agent" includes any active ingredient that is to be delivered into and/or onto a keratinous surface, such as, the skin, hair or nail at a desired location. Accordingly, since Herman fails to teach or suggest the method of depositing a benefit agent on a keratinous surface recited by the claim 1, Herman fails to anticipate claim 1. Applicants, therefore, respectfully request withdrawal of this rejection.

#### **IV. The Rejections Under 35 U.S.C. §103**

##### *A. The Rejection of Claims 2, 3, 10-17 and 20*

The Examiner has rejected claims 2, 3, 10-17 and 20 as allegedly unpatentable over Herman in view of U.S. Patent No. 6,046,145 ("Santora et al."). Recognizing that Herman fails to teach the limitations of claims 2, 3, 10-17 and 20, the Examiner relies upon Santora et al. Specifically, the Examiner argues that because Santora et al. teach shampoo compositions comprising anionic, amphoteric and anionic surfactants, fragrances, coloring agents, chelating agents, and from about 58.22 to about 70.5% water, it would be obvious to one of ordinary skill in the art to incorporate these ingredients in the ringing gel broadly disclosed by Herman. Applicants respectfully traverse this rejection.

As discussed above, Herman fails to teach or suggest Applicants' claimed method of depositing a benefit agent on a keratinous surface, said method comprising topically applying to said surface an effective amount of a ringing gel composition comprising (a) a surfactant phase ; (b) an oil phase; and (c) a benefit agent. There is nothing in the teachings of Herman that would provide one of ordinary skill in the art with the expectation that the ringing gel composition broadly disclosed by Herman could be used to deposit benefit agents to keratinous surfaces.

Santora et al. fails to remedy the deficiencies of Herman. As the Examiner is well aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the

prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Here, Santora et al. makes no mention of ringing gel compositions, much less, that ringing gel compositions could be used to deposit benefit agents to keratinous surfaces. The Examiner has failed to provide any teaching or suggestion in either of Herman or Santora et al. that would provide one of ordinary skill in the art with the motivation to incorporate the ingredients taught by Santora et al. into the ringing gel compositions disclosed by Herman. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01. Further, even if one of ordinary skill in the art was somehow motivated to incorporate the ingredient taught by Santora et al. into the Herman ringing gel compositions, there is nothing in the teachings of Herman or Santora et al. that would provide a reasonable expectation that such a modification of the Herman ringing gel compositions would be successful. Finally, since neither Herman nor Santora et al. teach or suggest a method for depositing a benefit agent, the combination of Herman with Santora fails to teach or suggest all the claim limitations.

Accordingly, Applicants respectfully submit that neither Herman nor Santora et al., taken alone or in combination render the present claims obvious. Therefore, the rejection should be withdrawn.

#### *B. The Rejection of Claims 4-9*

The Examiner has rejected claims 4-9 as allegedly unpatentable over Herman and Santora et al. as applied to claims 1-3, 10-17 and 20 and further in view of U.S. Patent No. 4,940,577 ("Greenberg et al.").

The Examiner relies upon Greenberg et al. for teaching the specific oil phase recited by claims 4-9. Specifically, the Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the ringing gel composition taught by Herman by incorporating certain ingredients taught by Santora et al. and further modify the composition by incorporating specific esters taught by Greenberg et al. because of "the expectation to have produced a clear microemulsion skincare composition with a smooth and non-tacky feel."

Greenberg et al. fails to remedy the deficiencies of Herman and Santora. There is nothing in the teachings of Greenberg et al., Herman and Santora, taken alone or in any

combination, that would provide one of ordinary skill in the art with the motivation to incorporate the ingredients taught by Santora et al. and Greenberg et al. into the ringing gel compositions disclosed by Herman, much less, a reasonable expectation that a ringing gel compositions with deposition properties could be obtained. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

### *C. The Rejection of Claims 18 and 19*

The Examiner has rejected claims 18 and 19 as allegedly unpatentable over Herman in view of Piechota.

The Examiner relies upon Piechota for teaching a method for treating acne and the specific oil phase recited by claims 18 and 19. Piechota relates to topical compositions which can be applied as a relatively low viscosity flowable liquid and which will quickly, upon contact with the warm surface of an animal, turn into a relatively high viscosity, essentially non-flowable, gel. Accordingly, the compositions taught by Piechota are distinct from the ringing gel compositions disclosed by Herman. Indeed, Piechota specifically teaches the disadvantages of compositions in the form of a gel prior to use. See col. 1, line 14 – col. 2, line 15.

The Examiner states that Piechota discloses ringing gel compositions. However, the only disclosure of ringing gels is at col. 3, lines 59-66. Here, Piechota is evaluating the effect of different poloxamers. Specifically, Piechota teaches that Pluronic F127 has the ability to form a ringing gel and as such “”would not lead one skilled in the art to employ Pluronic F127 to meet the objects of this invention in that such teachings are totally inimical to the objects of this invention; it is taught that the result is a gelled solution at room temperature i.e. one that cannot be filled, stored or dispensed as a flowable liquid.” See col. 3, line 66-col. 4, line 5. Clearly, Piechota teaches away from ringing gel compositions. Accordingly, one of ordinary skill in the art would not have been motivated to combine the teachings of Piechota with the teachings of Herman. Applicants, therefore, respectfully request that this rejection be withdrawn.

## **V. Conclusion**

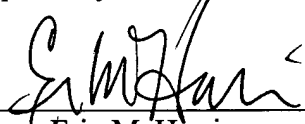
For the reasons set forth above, Applicants respectfully request withdrawal of all outstanding rejections. If the Examiner feels that a discussion with Applicants' representative

would be helpful in resolving the outstanding issues, the Examiner is invited to contact Applicants' representative at the number provided below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750/JBP-529/EMH. If a fee is required for an Extension of time 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

19. The method of claim ~~24~~ 18, wherein the anti-acne agent is selected from the group consisting of benzoyl peroxide, retinol, elubiol, antibiotics, salicylic acid, and mixtures thereof.